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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,071	09/27/2001	Terrence Sick	2000-05	2718
27157 7590 05/04/2007 GREENWALD & BASCH, LLP 349 WEST COMMERCIAL STREET, SUITE 2490 EAST ROCHESTER, NY 14445			EXAMINER CHANDLER, SARA M	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 05/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/965,071		SICK ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sara Chandler		3693	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/22/02</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 09/965,071 (09/27/01) filed on 03/15/07.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 3-6, 8,9,11-13,15-17** are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette, US Pat. No. 5,991,751.

**Re Claim 3:** Rivette discloses in an on-line service, a method for screening financial investment opportunities, comprising the steps of:

searching a financial database, including data for a plurality of companies, for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines

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42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information, databases) ;

searching an intellectual property database, including data for a plurality of companies, for data records associated with the at least one company based upon an intellectual property search criteria and retrieving the results thereof (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information).

combining the results of the financial database searching step and the intellectual property database searching step to determine common results on a company basis (Rivette, Fig. 7, col. 11, lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 "automatically analyzing the patent information 204 in conjunction with the financial information 216"); and

depicting the combined results (Rivette, Fig. 7, col. 11, lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 "automatically analyzing the patent information 204 in conjunction with the financial information 216").

**Re Claim 4:** Rivette discloses a method, wherein the method further comprises the step of analyzing the number of common results on a company basis to determine if the number is greater than zero (Rivette, col. 25, line 39+ - col. 30, line 6 searching module), and

if not relaxing the search criteria employed in at least one of the searching steps

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and rerunning the searches so as to obtain a non-zero number of common results (Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

**Re Claim 5:** Rivette discloses a method, wherein the step of relaxing the search criteria is accomplished without user intervention (Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

**Re Claim 6:** Rivette discloses a method, further including the step of maintaining the financial database data records and the intellectual property database records, wherein the step includes periodically launching an automated search of network resources to locate and update financial and intellectual property information', and storing the updated information in the respective database (Rivette, col 16, line 19+ -col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module).

**Re Claim 8:** Rivette discloses a method, further including the step of constructing a search query having both financial search criteria and intellectual property search criteria (Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

**Re Claim 9:** Rivette discloses a method, wherein the step of constructing a search query having both financial search criteria and intellectual property search criteria is facilitated by the step of displaying a search construction interface to a user (Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

**Re Claim 11:** Rivette discloses a system for screening financial investment opportunities, comprising (Rivette, Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23): a computer platform responsive to user input including access to at least a

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financial database including data records associated with a plurality of companies and an intellectual property database including data records associated with a plurality of companies (Rivette, Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -col. 22, line 24 databases; abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24);

programmable search software, operable by said computer platform, for searching the financial database for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof for storage in a first memory, said programmable search function also being employed for searching the intellectual property database for data records associated with at least one company based upon an intellectual property search criteria and retrieving the results thereof for storage in a second memory (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information ); search analysis software, operable by said computer platform, for combining the results of the financial database search and the intellectual property database search to determine common results(Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; Fig. 7, col. 11, lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11;

col 20, lines 12-21 "automatically analyzing the patent information 204 in conjunction with the financial information 216"); and

a display device for depicting the common results (Rivette, col. 15, line 5-8 display unit; Fig. 7, col. 11, lines 1-7; col. 12, lines 43-52; col. 13, lines 1-11; col 20, lines 12-21 "automatically analyzing the patent information 204 in conjunction with the financial information 216").

**Re Claim 12:** Rivette discloses a system, wherein said computer platform includes a client and a server interconnected by a network, and where the financial database and the intellectual property database are stored on devices accessible through said server Rivette, Figs. 3 e.g., clients, network, servers, databases ,4,5,6; col. 13, line 26+ - col. 15, line 23.

**Re Claim 13:** Rivette discloses a system, further including means for automatically relaxing search criteria employed by the programmable search software so as to obtain a non-zero number of search results (Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

**Re Claim 15:** Rivette discloses a system, wherein said display device is suitable for the display of at least one user-selectable data item to assist with the construction of a search query having both financial search criteria and intellectual property search criteria (Rivette, col. 15, line 5-8 display unit; col. 25, line 39+ - col. 30, line 6 searching module).

**Re Claim 16:** Rivette discloses a method for processing a search request having financial search criteria, comprising:

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sending the search request to a financial database, the financial database including at least financial data for a plurality of companies (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module);

receiving results, in response to the search request, from the financial database having at least one data record corresponding to the financial search criteria (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module);

determining that the search request includes intellectual property search

criteria (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information );

filtering said results for data records corresponding to said intellectual

property search criteria (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines



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65+ - col. 13, line 7; col. 15, liens 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information; F igs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information ); and presenting said filtered results (Rivette, col. 9, line 65+ -col. 10, line 3 ie., reporting, analyzing and planning; col. 20, lines 42-52).

**Re Claim 17:** Rivette discloses a method for processing a search request having intellectual property search criteria, comprising:

sending the search request to an intellectual property database, the intellectual property database including at least intellectual property data for a plurality of companies (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ -col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module);

receiving, in response to the search request, results from the intellectual property database having at least one data record corresponding to the intellectual property search criteria (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24; Figs. 3,4,5,6; col. 13, line 26+ - col. 15, line 23 computer; col 16, line 19+ - col. 22, line 24 databases; col. 25, line 39+ - col. 30, line 6 searching module);

determining that the search request includes financial search criteria (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, liens 37-45;

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col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information; F igs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information ); filtering said results for data records corresponding to said financial search criteria (Rivette, col. 14, lines 55-67; col. 15, lines 15-23 software; col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information; F igs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information ); and presenting said filtered results (Rivette, col. 9, line 65+ -col. 10, line 3 ie., reporting, analyzing and planning; col. 20, lines 42-52).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette, US Pat. No. 5,991,751.

**Re Claim 10:** Rivette fails to explicitly disclose a method, wherein said step of combining the results of the financial database searching step and the intellectual property database searching step, further comprises accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis. Official Notice is taken that it is old and well-known that publically available financial and intellectual property data concerns assignee and ticker data . For example, ticker information is used in investment reports, searching SEC documents and is published in newspapers. For example, assignee information is available in patent search databases. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Rivette to provide a method, wherein said step of combining the results of the financial database searching step and the intellectual property database searching step, further comprises accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis. As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

(See Documentary Evidence submitted in this Office Action)

**Claims 1,2,7 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette, US Pat. No. 5,991,751 in view of Black, US Pat. No. 6,012,042.

**Re Claim 1:** Rivette discloses in an on-line financial screening service, a method of searching a financial database, including data for a plurality of companies, and an intellectual property database, including data for a plurality of companies, in order to find securities matching user search criteria and relevant intellectual property, wherein the users access the database over the Internet (Rivette, abstract, col. 1, line 1+ - col. 4, line 30; col. 10, lines 8+ - col. 13, line 24), the method comprising:  
searching the database for records matching financial search criteria defined by a user (Rivette, Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information, databases ); and  
relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one (Rivette, col. 25, line 39+ - col. 30, line 6 searching module); and  
reporting the matching records to the user (Rivette, col. 9, line 65+ -col. 10, line 3 ie., reporting, analyzing and planning; col. 20, lines 42-52).

Rivette fails to explicitly disclose a method wherein reporting the matching records to the user, includes at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio,

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Cash/price ratio, Earnings per Share Growth- 1Yr, Earnings per Share Growth-IYr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio

Black discloses a method wherein reporting the matching records to the user, includes at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth- 1Yr, Earnings per Share Growth-IYr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio (Black, Figs. 3 and 4; col. 1, lines 45-65; and col. 2, lines 8-41 financial information).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Rivette by adopting the teachings of Black to provide in an on-line financial screening service, a method of searching a financial database and an intellectual property database in order to find securities matching user search criteria and relevant intellectual property, wherein the users access the database over the Internet, the method comprising: searching the database for records matching financial search criteria defined by a user; and relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one; and reporting the matching records to the user, including at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth- 1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

**Re Claim 2:** Rivette discloses a method, wherein the search criteria is suitable for being delimited between a minimum and maximum (Rivette, col. 25, line 39+ - col. 30, line 6 searching module).

**Re Claim 7:** Rivette discloses a method, wherein the updated information includes: financial data (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, liens 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information, databases), and

at least one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor Country, Claims), Attorney or Agent, Description/specification, Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4,

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line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information).

Rivette fails to explicitly disclose a method, wherein the updated information includes:

at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio,

Black discloses a method, wherein the updated information includes: at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Rivette by adopting the teachings of Black to provide in an on-line service, a method for screening financial investment opportunities, comprising the steps of: searching a financial database for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof; searching an intellectual property database for data records associated with at least one company based upon an intellectual property search criteria and retrieving the results thereof; combining the results of the financial

database searching step and the intellectual property database searching step to determine common results on a company basis; and depicting the combined results.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

**Re Claim 14:** Rivette discloses a system, including a financial database includes records having financial data (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 1,2,4,6; abstract; col. 3, line 59+ - col. 4, line 4; col. 10, lines 17-39; col. 11, lines 1-7; col. 12, lines 44-52; col. 12, lines 65+ - col. 13, line 7; col. 15, lines 37-45; col. 16, lines 42-52; and col. 21, lines 59+ - col. 22, line 6 refs. non-patent information, financial information, databases), and where said intellectual property database includes records having at least one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor Country, Claims), Attorney or Agent, Description/specification, Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type (Rivette, col. 25, line 39+ - col. 30, line 6 searching module; Figs. 12a-m; abstract; col. 3, line 59+ - col. 4, line 3; col. 4, line 15-21; col. 10, lines 8-16 and lines 45-48; col. 16, lines 53-67 ref. patent information).



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Rivette fails to explicitly disclose a system, wherein said financial database includes records having at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio.

Black discloses a system, wherein said financial database includes records having at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Rivette by adopting the teachings of Black to provide a system, wherein said financial database includes records having at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/cash Flow Ratio, and where said intellectual property database includes records having at least one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor Country, Claims), Attorney or Agent, Description/specification,

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Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type.

As suggested by Rivette one would have been motivated to use publicly available patent related information and non-patent related information (e.g., financial information) to make business decisions.

### ***Response to Arguments***

#### **IDS**

The objection to the IDS has been withdrawn and references cited in IDS (03/22/02) considered.

Applicant's arguments filed 03/15/07 have been fully considered but they are not persuasive.

#### **102/103**

#### **Multi-party/Plurality of Companies**

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., While Rivette refers to information about competitor companies, it does not appear to contemplate the searching of multi-company financial and intellectual property databases) are not recited in the rejected claim(s). Although the claims are interpreted

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in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claimed invention recites:

searching a financial database, including data for a plurality of companies, for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof;  
searching an intellectual property database, including data for a plurality of companies, for data records associated with the at least one company based upon an intellectual property search criteria and retrieving the results thereof;

Rivette discloses the claimed subject matter. First, when Rivette discloses that a “non-patent information” database can be searched (i.e., such as a database of financial information), the data contained in the database is for a plurality of companies. For example Rivette suggests that the non-patent information “of interest” can pertain to variety of legal and/or financial papers). Thus, at a minimum that database would hold data for other companies such as financiers, partners, competitors etc. (Rivette, col. 10, 17-22). Second, patents are issued to a plurality of companies. When Rivette discloses that patents “of interest” can be searched in the patent database that means that patents for a plurality of companies can be searched (e.g., a company, its competitors). Rivette suggests, that there is an interest in providing this sort of data for a plurality of companies in cases such as patent infringement, competition etc. (See Rivette col. 1 lines 36-48; col. 2, lines 29-33; and col. 3, lines 52-56). See also other cited portions of Rivette supra.

In response to applicant's arguments, the recitation has not been given patentable weight in regards to 1 and 2 because the recitation occurs in the preamble.

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A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Furthermore, mere duplication of parts has no patentable significance unless a new and unexpected result are produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Lastly, the amendment to claim does not change the process steps required for searching.

#### Official Notice (Documentary Evidence)

#### Patent Assignee as Patent or Intellectual Property Information in searching and databases

##### (1) Dialog

patent assignee dialog – Google News Archive Search (1980-2000). (5 pages)

##### (2) LexisNexis

patent assignee lexisnexis – Google News Archive Search (1980-2000). (1 page)

##### (3) STN

patent assignee stn – Google News Archive Search (1980-2000). (2 pages)

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Ticker Information as Business, Finance or Economic Information in searching and databases

(1) Dialog

ticker dialog business or finance or economic – Google News Archive Search (1980-2000). (23 pages)

(2) LexisNexis

ticker lexisnexis business or finance or economic – Google News Archive Search (1980-2000). (13 pages)

Patent or Intellectual Property Information and Business, Finance or Economic Information in searching and databases

(1) Dialog

patent ticker dialog business or finance- Google News Archive Search (1980-2000). (2 pages)

(2) LexisNexis

patent ticker dialog business or finance- Google News Archive Search (1980-2000). (1 page)

(3) STN

patent ticker lexisnexis business or finance- Google News Archive Search (1980-2000). (1 page)

Motivation to modify Prior art

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there

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is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Claim 10 depends from Claim 3 in which the Examiner cited along with other citations (Rivette, col. 3, line 59+ - col. 4, line 3) and Claim 4 in which the Examiner cited (Rivette, col. 25, line 39+ - col. 30, line 6 searching module). Pg. 3, lines 52-56) provides that it would be beneficial to use automated tools to process patent and non-patent information to aid in making business decisions. Pg. 25, lines 50-65 of Rivette provides that the data in the database is indexed to facilitate and enhance searching by the search engine and that any well-known method of indexing can be used. Indexing patent data based on patent assignee and financial data based on ticker information was well-known in the art. Pg. 25, lines 39-42 of Rivette provides that conducting the searching according to commercial and well-known search engines is also considered. The knowledge among those providing commercial search engines to index ticker and financial information; patent assignee and patent information; and to link patent and financial information was also well-known. In light of these teachings, it would have been obvious to modify the teachings of Rivette to provide a method further comprising: wherein said step of combining the results of the financial database searching step and the intellectual property database searching step, further comprises accessing an assignee/ticker database to determine linkages between the financial

database and the intellectual property database on a company basis. See also, Official Notice (Documentary Evidence) supra.

Relaxing Search Criteria

The claimed invention recites:

relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one;

The claims have been given their broadest reasonable interpretation consistent with MPEP § 2111. In the Office Action, Rivette, col. 25, line 39+ - col. 30, line 6 was cited as corresponding to this limitation in the claim. The limitation “relaxing at least some of the search criteria, until at least a required number of matching records are found” was interpreted as being synonymous with modifying, adjusting or manipulating search terms or criteria. This process is what is done during a search however. For example, if a user is searching for a person named John Doe in California he may conduct search of individuals with that name. If the user receives too many results he would “modify, adjust or manipulate” the search terms or criteria by narrowing the scope by adding requirements (e.g., John Doe resides in Orange County, is between 50-60 and is male) which will likely reduce the number of matching results. If the user does not receive any results or too few results he would “modify, adjust or manipulate” the search terms or criteria by broadening the scope by relaxing the requirements (e.g., John Doe could be John Don, or California could be the West Coast/Region). Thus language in the description of the search module such as “iterative” (Rivette, col. 26, lines 24-28); “search strategies” (Rivette, col. 26, lines 29-33); “manipulate” (Rivette,

col. 26, lines 40-46) are interpreted as reading upon the claim language. See also other cited portions of Rivette supra. Furthermore, Rivette requires that a result is given (i.e., at least one record; outcome), because no record (i.e., no record, outcome) would not address the problems and purpose sought to be resolved by Rivette.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

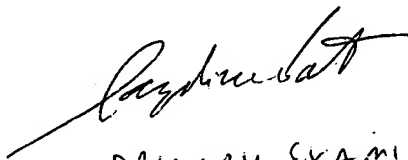


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

  
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